

REMARKS

Claims 1-14 are pending in this application. Claims 1, 2, 4-6, and 12-14 stand rejected and claims 3 and 7-11 are objected to. Applicant wishes to thank the Examiner for the indication of allowable subject matter in claims 3 and 7-11. In light of the remarks set forth below, Applicant respectfully submits that each of the pending claims is in immediate condition for allowance.

Applicant acknowledges the indication of allowable subject matter in dependent claims 3 and 7-11. Applicant defers rewriting these claims in independent form until final resolution of the base claims from which they depend.

Claims 1, 2, and 13 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,104,708 ("Bergamo"). Applicants respectfully request reconsideration and withdrawal of this rejection.

To anticipate a claim under 35 U.S.C. § 102, the cited reference must disclose every element of the claim, as arranged in the claim, and in sufficient detail to enable one skilled in the art to make and use the anticipated subject matter. See, PPG Industries, Inc. v. Guardian Industries Corp., 75 F.3d 1558, 1566 (Fed. Cir. 1996); C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1349 (Fed. Cir. 1998). A reference that does not expressly disclose all of the elements of a claimed invention cannot anticipate unless all of the undisclosed elements are inherently present in the reference. See, Continental Can Co. USA v. Monsanto Co., 942 F.2d 1264, 1268 (Fed. Cir. 1991).

Among the limitations of independent claim 1 that is neither taught or disclosed in Bergamo is a “control data generator for generating control data from a frequency difference between the frequency band and the predetermined frequency band.” Similarly, claim 13 is a method claim which requires “generating control data from a frequency difference between the frequency band and the predetermined frequency band.”

Neither the apparatus nor the method of using the apparatus recited in Applicant’s claims is disclosed in Bergamo. The Office Action asserts that the control data generator for generating control data from a frequency difference between a frequency band and the predetermined frequency band as shown by elements 87 and 89 in Figure 6 of Bergamo. Applicant respectfully disagrees.

In Bergamo, IQ accumulator 87 accumulates the ATM cell preambles, i.e., the overhead bytes are accumulated at IQ accumulator 87. The unique word byte is then detected at block 89. Bergamo specifically states that the “[D]etection of the unique word allows **identification of the phase** which provides the detection of the unique word and thus also the data payload.” (Col. 8, line 66 to col. 9, line 1). This identified phase is then used in the demodulation of the received payload. (Col. 9, lines 1-4).

In contrast to Bergamo’s system, Applicant’s claimed control data generator generates the control data from a frequency **difference** not a phase difference like Bergamo. Bergamo explicitly states that its frequency adjustments occur prior to the receipt of the IF signal by the circuitry of Figure 6 as cited in the Office Action (see col. 8, lines 46-51). Accordingly, Applicant respectfully submits

that Bergamo does not teach or suggest the control data generator of claim 1, which generates control data from a frequency difference.

Likewise, in corresponding method claim 13, the control data which is generated from a frequency difference between the frequency band and the predetermined frequency band is not disclosed by the accumulating of overhead bytes and unique word detection performed by Bergamo. Thus, independent claims 1 and 13 are allowable over Bergamo. Thus, Applicant respectfully requests that the rejection of claims 1 and 13 be withdrawn.

Claims 2 and 4 depend from, and contain all the limitations of claim 1. These dependent claims also recite additional limitations which, in combination with the limitations of claim 1, are neither disclosed nor suggested by Bergamo and are also believed to be directed towards the patentable subject matter. Thus, claims 2 and 4 should also be allowed.

Paragraph 5 of the Office Action rejects claims 5, 6, 12, and 14 under 35 U.S.C. § 103(a) as being unpatentable over Bergamo in view of U.S. Patent No. 4,737,724 ("Porrot"). Independent claims 5, 12, and 14 each require a control data generator similar to control data generator of claim 1. As discussed above with reference to claim 1, Bergamo fails to disclose the control data generator explicitly recited in Applicant's claims. The Office Action includes Porrot not to disclose the deficiency in Bergamo discussed above but to show additional features such as the band pass filter of claims 5 and 14 which the Office Action readily admits are not disclosed by Bergamo. However, because Porrot fails to cure the deficiencies of

Bergamo discussed above, these claims are also allowable over the combination of Bergamo and Porrot.

Claim 6 depends from, and contain all the limitations of claim 5. This dependent claim also recites additional limitations which, in combination with the limitations of claim 5, are neither disclosed nor suggested by Bergamo and are also believed to be directed towards the patentable subject matter. Thus, claim 6 should also be allowed.

Applicant includes herewith a set of replacement Figures for Figures 1-10. No new matter has been added.

Applicant has responded to all of the rejections and objections recited in the Office Action. Reconsideration and a Notice of Allowance for all of the pending claims are therefore respectfully requested.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

Application No.: 09/549,279

Docket No.: K2291.0085/P085

If the Examiner believes an interview would be of assistance, the Examiner is welcome to contact the undersigned at the number listed below.

Dated: November 7, 2003

Respectfully submitted,

By 

Ian R. Blum

Registration No.: 42,336

DICKSTEIN SHAPIRO MORIN &
OSHINSKY LLP

1177 Avenue of the Americas - 41st Floor
New York, New York 10036-2714
(212) 835-1400
Attorney for Applicant

IRB/mgs
Attachments